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OFFICE OF PETITIONS

In re Application of
Andrew Ernest Fano
Application No. 09/975,460
Filed: October 10, 2001
Attorney Docket No. 10022/187

ON PETITION

This is a decision on the petition filed January 22, 2002, requesting that the above-identified application be accorded a filing date of October 10, 2001.

On October 10, 2001, applicant filed the above-identified application, which is a continuation application under 37 CFR 1.53(b) of prior application, No. 09/259,902, filed February 26, 1999. This continuation application included, inter alia, a complete copy of the prior application, and a transmittal letter. The transmittal letter contained an instruction to "[c]ancel in this application original claims 1-19 of the prior application and otherwise enter the attached preliminary amendment before calculating the filing fee. (At least one original independent claim must be retained for filing purposes)." As indicated in the present petition, applicant did not file a preliminary amendment with the application papers on October 10, 2001. Thereafter, on January 7, 2002, applicant submitted a preliminary amendment, which contained instructions to delete claims 1-19 but add 22 new claims prior to examination on the merits.

On November 21, 2001, the Office of Initial Patent Examination mailed a Notice of Incomplete Nonprovisional Application (Notice), stating that a filing date had not been accorded to the present application because the specification did not include at least one claim as prescribed by 35 U.S.C. § 112.

In response, on January 22, 2002, applicants filed the present petition requesting the application be accorded a filing date of October 10, 2001. Applicant's attorney stated that the application was filed with the Amendment Instruction Box inadvertently and erroneously checked to instruct the cancellation of all of the claims. The attorney stated that he intended to cancel the claims only when the later preliminary amendment was filed. Furthermore, applicant's attorney indicated that the instruction of the Amendment Instruction Box did not

permit the United States Patent and Trademark Office to cancel all of the claims in the application. Applicant's attorney argued the instructions stated that at least one original independent claim must be retained for filing purposes. Moreover, the attorney asserted: "Since a preliminary amendment was not enclosed with the continuation application, and could therefore not be entered, the Patent and Trademark Office should therefore have recognized the impossibility of following the instructions as written." *Petition dated January 22, 2002, p. 4.* "The Patent and Trademark Office should therefore have ignored the instructions and left all of the original claims 1-19 in the application as filed." *Id.*

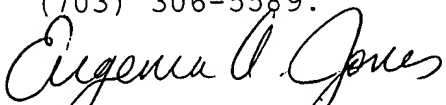
The Office notes that in Exxon Corp. v. Phillips Petroleum Co., 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001), the Federal Circuit affirmed that the United States Patent and Trademark Office (Office) may refuse to enter an improper amendment that would cancel all of the claims in an application to avert harm (loss of a filing date) to an applicant. Consistent with Exxon, the Office will deny entry of any amendment that seeks cancellation of all claims but does not present any new or substitute claims. For fee calculation purposes, however, the Office will treat such an application as containing a single claim.

Applicant's instruction to cancel claims 1 through 19, the only claims pending in the application, is improper. A patent application must contain at least one claim pursuant to 35 U.S.C. § 112. Accordingly, the Office will not enter the improper amendment. The Notice of Incomplete Nonprovisional Application is hereby vacated.

Accordingly, the petition is granted. The petition fee of \$130.00 is unnecessary and will be credited to Deposit Account No. 23-1925.

The application will be forwarded to the Office of Initial Patent Examination for further processing to correct the filing date to October 10, 2001, as well as to indicate in the record that the application was filed with a total of one (1) total claim, including a single independent claim. Thereafter, the application will be forwarded to Technology Center 3600 for examination in due course.

Any inquiries related to this decision should be directed to Senior Petitions Attorney Christina Tartera Donnell at (703) 306-5589.



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